# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/725,154 | 12/01/2003 | Walt Singleton | 2002P19675 US01 | 1773 |

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| 7590          01/12/2006 | EXAMINER |
| Alexander J. Burke | BOTTS, MICHAEL K |
| Intellectual Property Department | |

| | | |
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| 5th Floor | ART UNIT | PAPER NUMBER |
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DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/725,154 | SINGLETON ET AL. |
| | Examiner | Art Unit |
| | Michael K. Botts | 2176 |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on _02 December 2002 and 01 December 2003_.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-17_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _01 December 2003_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *  c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _12/1/03_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.    This document is the first Office Action on the merits.  This action is responsive

to the following communications:  The Non-Provisional Application, which was filed on

December 1, 2003, and which claims priority to Provisional Application number

60/430,220, which was filed on December 2, 2002, and an Information Disclosure

Statement (IDS), which was filed on December 1, 2003.

2.    Claims 1-17 have been examined, with claims 1, 13, 14, and 15 being the

independent claims.

3.    The Drawings is objected to.

4.    Claims 1-17 are rejected.


### *Information Disclosure Statement*

5.    An initialed and dated copy of applicant's IDS form 1449, which was filed on

December 1, 2003, is attached to this Office Action.


### *Drawings*

The drawings are objected to because of the following:  This application contains

a computer program listing of more than three hundred (300) lines.  In accordance with

37 CFR 1.96(c), a computer program listing contained on more than three hundred

(300) lines, <u>must</u> be submitted as a computer program listing appendix on compact disc

conforming to the standards set forth in  37 CFR 1.96(c)(2) and must be appropriately

referenced in the specification (see  37 CFR 1.77(b)(5)).  Accordingly, applicant is

required to cancel the current computer program listing, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

In addition, corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *The Specification*

6.      Applicant is required to update the status (pending, allowed, etc.) of all parent

priority applications in the first line of the specification.  The status of all citations of U.S.

filed applications in the specification should also be updated where appropriate.

### *Limitation on Priority*

The Non-Provisional application, which was filed on December 1, 2003, claims

priority to a provisional application, which was filed on December 2, 2002.  For the

reasons supported below, some elements or limitations of the claims are not entitled to

the earlier priority date, and the earliest effective filing date for those elements or

limitations is set at December 1, 2003.

Regarding **dependent claim 4**:  The optional limitation of a "flat file," was not

disclosed in the Provisional Application.

Regarding **dependent claim 17**:  The steps of receiving selections of electronic

document templates and sources of data items was not disclosed in the Provisional

Application.

### *Claims Rejection – 35 U.S.C. 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal, B., "Applied XML Solutions, The Authoritative Solution," Sam's, 2000, [hereinafter "Marchal"], and further in view of Muench, S., "Building Oracle XML Applications," O'Reilly & Associates, 2000, [hereinafter "Muench"].

Regarding **independent claim 1**, Marchal in view of Muench teaches:

*A document generation system for producing a document from information derived from an information repository, comprising:*

*a source of code representing a document template including, data fields containing placeholder items to be replaced by desired data items, and also including a repetition identifier indicating one of said data fields is to be replicated to provide a group of data fields to be replaced by a plurality of said desired data items;*

*a source of document generation control information supporting insertion of said desired data items derived from said information repository in said data fields; and*

*a document processor for applying said control information in replacing template document data field placeholder items with desired data items, to produce a generated document.*

(See, Marchal, pages 71-102, particularly figures 3.8 and 3.11, teaching a document template with placeholders in data fields to be replaced with desired data items. Marchal also teaches a source of document generation control information supporting insertion of the desired data items from an information repository. See, Marchal, pages 71-102, particularly pages 73-84, teaching code to generate insertion of desired data into data fields. Marchal also teaches a document processor for applying the control information in replacing template document data field placeholder items with desired data items to produce a generated document. See, Marchal, pages 71-102, particularly pages 73-84, teaching code to generate insertion of desired data into data fields. See also, Marchal, figure 7.8 and pages 209-214.

Marchal does not explicitly teach a repetition identifier indicating data fields to be replicated to provide a group of data fields to be replaced by a plurality of said desired data items.

Muench teaches identification, control, and rendering data fields with duplicate or repetitious data. See, Muench, pages 375-387, teaching sorting a grouping repeating data, and pages 433-499, particularly pages 470-475, teaching managing and display of repeating data fields.

At the time the invention was made, it would have been obvious to one or ordinary skill in the art to combine the teachings of Marchal and Muench to create a form template that handles repeating data items. The suggestion or motivation for making such combination is because both references are in the same field of endeavor,

creating and manipulating electronic forms creation and data insertion into electronic

forms.)


Regarding **dependent claim 2**, Marchal in view of Muench teaches the limitations of

claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said control information contains at least one of, (a) an identification of*
>
> *data fields in said template document available to be replaced by desired data*
>
> *items, (b) an identification of a location in said information repository of a desired*
>
> *data item associated with an individual data field, and (c) an identification of a*
>
> *location in said information repository of a first data item for insertion in said*
>
> *individual data field of said group of data fields and data items sequentially linked*
>
> *to said first data item are inserted in remaining data fields of said group of data*
>
> *fields.*

(See, Marchal, pages 71-102, and see also, figures 7.7 and 7.8, and pages 208-214,

teaching the identification of data fields in the template document available to be

replaced by desired data items.)


Regarding **dependent claim 3**, Marchal in view of Muench teaches the limitations of

claims 1 and 2 above, and further teaches the following:

> *The system according to claim 2, wherein*

> *said location identifier of said first data item comprises an Extensible*
>
> *Markup Language compatible XPath value.*

(See, Marchal, pages 330-336, particularly 333-336, teaching the use of XPath to select

elements in a source XML document.)

Regarding **dependent claim 4**, Marchal in view of Muench teaches the limitations of

claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said data source file comprises at least one of, (a) a comma delimited file and (b)*

*a flat file.*

(See, Marchal, pages 165-194, teaching tokenizing input files.)

Regarding **dependent claim 5**, Marchal in view of Muench teaches the limitations of

claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said repetition identifier comprises a Rich Text Format (RTF) compatible*

*Bookmark.*

(See, Marchal, pages 129-166, teaching conversion of XML document to RTF,

inherently including conversion of XML bookmarks and repetition identifiers to RTF.)

Regarding **dependent claim 6**, Marchal in view of Muench teaches the limitations of

claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said code representing a document template is Rich Text Format (RTF)*
>
> *compatible.*

(See, Marchal, pages 129-166, teaching conversion of XML document to RTF.)

Regarding **dependent claim 7**, Marchal in view of Muench teaches the limitations of claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said document processor processes template document data, excluding*
>
> *said desired data items inserted in said placeholder items, by incorporating said*
>
> *template document data in said generated document and said generated*
>
> *document is compatible with Extensible Stylesheet Language (XSL).*

(See, Marchal, pages 329-333 teaching XSL attributes in XML templates. See also, Marchal, pages 122-123, teaching use of XSL style sheets with an XML document.)

Regarding **dependent claim 8**, Marchal in view of Muench teaches the limitations of claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said generated document comprises one or more of, (a) an SGML*
>
> *document, (b) an XML document, (c) an HTML document, and (d) a multimedia*
>
> *file.*

(See, Marchal, pages 103-127, teaching generation of the document in SGML, XML, and HTML.)

Regarding **dependent claim 9**, Marchal in view of Muench teaches the limitations of claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said desired data items derived from said information repository are*
>
> *Extensible Markup Language (XML) compatible data items derived from an XML*
>
> *compatible document.*

(See, Marchal, page 168, and pages 329-336, teaching import of XML files through an XSLT processor.)

Regarding **dependent claim 10**, Marchal in view of Muench teaches the limitations of claim 1 above, and further teaches the following:

> *The system according to claim 1, wherein*
>
> *said document processor processes template document data in Rich Text*
>
> *Format (RTF) together with desired data items derived from said information*
>
> *repository in Extensible Markup Language (XML) to provide said generated*
>
> *document in an Extensible Stylesheet Language (XSL) format.*

(See, Marchal, pages 129-166, teaching XML and RTF file. See, also Marchal, pages 103-127, and 329-226 teaching generation of the document in XSL format.)

Regarding **dependent claim 11**, Marchal in view of Muench teaches the limitations of

claims 10 and 1 above, and further teaches the following:

> The system according to claim 10, wherein
>
> said document processor includes an XML parser to process said
>
> generated document in Extensible Stylesheet Language (XSL) format to provide
>
> a processed document in Rich Text Format (RTF).

(See, Marchal, pages 168-194, teaching XML parsers. See also, Marchal, pages 129-

166, and particularly 144-145, teaching XML document to RTF generation using XSL.)


Regarding **dependent claim 12**, Marchal in view of Muench teaches the limitations of

claim 1 above, and further teaches the following:

> The system according to claim 1, wherein
>
> said document processor examines said document template to identify an
>
> individual data field containing a placeholder item and incorporate a link in said
>
> individual data field identifying a corresponding item in said document generation
>
> control information, said corresponding item enabling locating one of said desired
>
> data items in said information repository for insertion in said individual data field.

(See, Marchal, pages 71-102, teaching links from information repositories to data fields

containing placeholder items in a form template.)

Regarding **independent claim 13**, claim 13 incorporate substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

The image generator is implicitly shown by the images generated and taught in Marchal, figures 3.7-3.13,and page 71-102.)

Regarding **independent claim 14**, claim 14 incorporates substantially similar subject matter as claimed in claim 1, and is rejected along the same rationale.

Regarding **independent claim 15 and dependent claim 16**, claims 15 and 16 incorporate substantially similar subject matter as claimed in claims 1 and 7, respectively, and are rejected along the same rationale.

Regarding **dependent claim 17**, Marchal in view of Muench teaches the limitations of claim 15 above, and further teaches the following:

> *A method for producing a document according to claim 15, further comprising the steps of:*
>
> > *receiving a selection of the electronic document template; and*
> >
> > *receiving a selection of a source of the data items.*

(See, Muench, pages 288-309, teaching creation and uses of multiple electronic document templates. See, Muench, pages 284-288, teaching multiple source data inputs.)

It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the references should not be considered to

be limiting in any way.  A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.


### *Conclusion*

7.     The following prior art is made of record and not relied upon that is considered

pertinent to applicants' disclosure:

Kraft, et al. (U.S. Patent 6,084,585), teaching use of a graphical user interfaces

to assist in forms completion, including forms with placeholders.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael K. Botts whose telephone number is 571-272-

5533.  The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on 571-272-4136.  The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


MKB/mkb


WILLIAM BASHORE
PRIMARY EXAMINER

12/27/2005